

In the Office Action mailed 7 December 1999, the Examiner rejected a number of claims as including non-statutory subject matter; raised a series of objections to the claims as indefinite; rejected claims 1 and 18 as anticipated by Hisada; and rejected claims 2-17 as obvious over Hisada either taken alone or in view of one or more other references. Applicant submits that the present claims are in condition for allowance and requests the Examiner's reconsideration of the original rejection.

Turning first to the Examiner's rejection under §101, applicant respectfully submits that the Examiner's position directly contradicts both logic and the Office's long-established claim practice. The Examiner apparently feels that applicant is reciting "a human body or parts thereof" as a positive claim element. This simply is not the case. Applicant has simply referenced the position or action of a rider which may use the vehicle. At no time does applicant positively recite the rider or any part of his or her body as an element of the claimed invention. If the Examiner wishes, applicant could provide a long list of patents issued by the Office which includes analogous claim language. As one handy example, the Hisada reference on which the Examiner extensively relies specifically indicates in claim 1 that the vehicle has "a seat designed to be straddled by an operator." Accordingly, applicant respectfully submits that the Examiner's position is untenable.

The Examiner raised a series of objections to claims 1, 5, 6, 17 and 18 under the second paragraph of §112. Applicant disagrees with the Examiner's position in each of these rejections and submits that all of the claims as filed were sufficiently clear to meet the standards of §112. In the interest of advancing prosecution, though, applicant has amended each of these claims in an attempt to address the Examiner's concerns. As such, applicant believes the rejections under §112 to be obviated by the present amendment.

Turning to the substantive claim rejections, the Examiner rejected claims 1 and 18 as anticipated by Hisada and rejected the rest of the claims as obvious over Hisada either viewed alone or in combination with one or more other patents. Applicant

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respectfully submits that the present claims are readily distinguishable from and unobvious over Hisada and requests reconsideration by the Examiner.

Hisada discloses a brake pedal for use with a vehicle such as an ATV. There is never a need to insert any part of the user's foot beneath the brake pedal as it will always be biased away from the depressed braking position by the cable 56. This is standard practice with brakes – they operate only when the rider depresses the pedal. In operating a manual shift lever, though, one may need to manually lift the shift lever upwardly to shift the manual transmission between the different gears.

Not only would an operator never need to insert a foot beneath the Hisada brake pedal, Hisada takes steps to prevent this. Hisada includes a special bracket 27k for the sole purpose of preventing the operator's foot from getting beneath the brake pedal. It seems likely that permitting an operator's foot to slip under there would reduce the safety and efficacy of Hisada's device, prompting Hisada to go through the extra expense and trouble of putting a separate element on the brake pedal specifically to avoid this eventuality.

Turning to the present claims, each of the claims in the application requires that the operator be able to position at least a portion of a foot beneath the shift lever. This arrangement permits certain types of manual shift levers to be employed without interfering with their operation. If the foot rest were positioned too close to the shift lever or if the shift lever had a bracket carried on it which prevented entry of a foot beneath the shift lever (like Hisada's bracket 27k), this simple, common type of shift lever could not be used very effectively. Consequently, claims 1 and 18, as amended, are readily distinguishable from and are not anticipated by Hisada's teachings.

Applicant further submits that each of claims 1-18 is unobvious over Hisada's teachings. For the reasons explained above, Hisada explicitly teaches against permitting an operator to insert part of his or her foot beneath the brake pedal. Accordingly, applicant cannot see how these claims would be obvious over Hisada viewed alone.

In rejecting original claims 2, 7-9 and 17, the Examiner combined the teachings of Hisada with those of Graves. The Examiner admitted that Hisada did not teach positioning the shift lever at a position to permit the rider to insert at least a portion of a foot beneath the shift lever. Graves was cited as showing a spacing which permits the 5 rider to insert a portion of a foot beneath the shift lever. Applicant is fairly confused by what the Examiner considers to be the toe portion of Graves' design. There appears to be a simple gap between the foot peg 32 and the forward portion 44 of the barrier platform 42. Clarification of the Examiner's reading of Graves would be greatly appreciated.

10 Even if the Examiner's interpretation of Graves' teaching were warranted, though, applicant respectfully submits that the combination of these references would not yield the claimed invention. Hisada's safety teachings, requiring the addition of a separate bracket 27k to preclude entry of a foot beneath the brake, seem quite important. Simply pointing out that someone else uses a foot peg and a manual shift 15 lever which is to be lifted to shift the transmission would not lead one to directly contradict Hisada's teachings. To the contrary, the Examiner's proposed modification would destroy the utility of the bracket 27k and potentially compromise the safety of Hisada's brake. Consequently, applicant submits that the proposed combination would not render the present invention obvious.

20 Applicant further submits that there is no motivation to combine the teachings of Hisada with those of Graves. The foot rest of Hisada is specifically adapted to permit use with the brake pedal taught therein and that pedal is designed to keep the operator's toes from slipping beneath the "foot stepping portion 27c." Graves utilizes a shift lever which has a significantly different mode of operation and different sets of 25 safety issues. As there is no readily apparent motivation in either of these references suggesting their combination, applicant submits that the proposed combination is improper and illogical.

Even if one were to come up with a reason that someone may theoretically be led to combine the teachings of Hisada and Graves, it is unclear to applicant what such

a combination would look like. Given the competing design concerns of these two devices, applicant cannot see how this would be accomplished. It does seem plain, though, that the only teaching which would lead one to select the presently claimed structure from all of the theoretical possibilities presented by these two disparate references is applicant's own disclosure. Using applicant's specification as a roadmap to pick and choose selected portions of prior art references to arrive at a claimed invention is improper hindsight analysis, and applicant respectfully submits that all of the present claims would be unobvious over such a theoretical combination of Hisada and Graves.

With respect to claims 7 and 8, the Examiner cited the Walters et al. design patent owned by the assignee of the present application. The Examiner also cited Millican in connection with two different rejections of claim 17. Neither of these references cure the defects noted above or would lead one to arrive at the presently claimed invention. The Walters et al. reference does not teach use with a shift lever and it is unclear how this teaching would be combined with that of any of the other references. To the extent that it were combined with Hisada's teachings in some fashion, this still would appear to require that the system prevent an operator from inserting a foot beneath the foot stepping portion 27c of a brake pedal. Millican, like Graves, has a shift lever which is suspended over a relatively large opening. It is unclear what the Examiner would characterize as a toe portion of this structure. If the Examiner believes that Millican does teach a toe portion which is relevant to the present claims, applicant would be grateful if the Examiner could explain his interpretation of this reference and how it could possibly be combined with Hisada's brake pedal to arrive at the present invention without utilizing applicant's own teachings in a hindsight analysis.

In light of the above, applicant respectfully submits that all of the present claims define inventively over the prior art of record. The present amendment also addresses the Examiner's objections to the definiteness of the claims. Accordingly, the present application is believed to be in condition for allowance, prompt notice of which is courteously solicited. If the Examiner has any questions or believes that prosecution of

this application can be advanced by a telephonic interview, he is encouraged to call the undersigned at the number listed below.

Respectfully submitted,



Dated: 7 June 00

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